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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,361

07/06/2005

Yoshinobu Sato

37808-0011

3251

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7590

01/14/2009

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EXAMINER

DELCOTTO, GREGORY R

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

01/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/541,361</p>	<p>Applicant(s) SATO ET AL.</p>	
	<p>Examiner Gregory R. Del Cotto</p>	<p>Art Unit 1796</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 29 December 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Gregory R. Del Cotto/
Primary Examiner, Art Unit 1796

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not sufficient to overcome the rejection(s) set forth in the Office action mailed 7/28/08 which have been maintained for the reasons of record. Additionally, Applicant states that while the Examiner has relied upon a theory of inherency, there is no showing that any of claim elements A, B, C, or D necessarily must have been present in any cited reference. Specifically, Applicant states that the reference make no mention of ion pairing as recited by the instant claims. Furthermore, Applicant states that unexpected results have been presented which show the unexpected and superior properties of the claimed invention in comparison to compositions falling outside the scope of the instant claims. In response, note that, the Examiner asserts that the compositions as disclosed by the prior art of record would inherently teach ion pair surfactants as recited by the instant claims because the prior art of record teaches mixtures of N-acyl amino acids and a second amino acid which would inherently form an ion pair when mixed. Further, note that, once a reference teaching a product appearing to be substantially identical is made the basis of a rejection and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference. See MPEP 2111. The Examiner has provided technical reasoning which tends to show the inherency of the claimed subject matter and Applicant has provided no data which shows that the products disclosed by the prior art of record are not inherently the same as recited by the instant claims. Thus, the Examiner maintains that the prior art of record is sufficient to anticipate the material limitations of the instant claims under 35 USC 102.

With respect to the data presented, the Examiner asserts that the rejection of the instant claims under 35 USC 102 has been maintained and that secondary considerations such as data presenting unexpected and superior results is not sufficient to overcome a rejection under 35 USC 102. Alternatively, even if the prior art of record was not sufficient to reject the instant claims as anticipated under 35 USC 102, the Examiner asserts that the data presented would not be persuasive. Note that, Applicant has submitted the data as part of the attorney arguments and not part of a separate affidavit of declaration which is not proper. To be of any probative value any secondary considerations such as alleged evidence of unexpected and superior results must be in the form of a properly executed affidavit or declaration. See MPEP 716.